REMARKS

Claims 1-18 are pending in the application. Claims 1-4[1], 6, 8, 9, 13, 14, 16 and 17 are rejected under 35 U.S.C. § 103(a) as being unpatentable over Scifres *et al.* (U.S. Patent No. 4,656,641; hereinafter "Scifres") in view of Shin (U.S. Patent No. 6,242,328; hereinafter "Shin"). Claims 5, 7, 10-12, 15 or 18 are objected to as being dependent upon a rejected base claim, but would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims. Applicant adds claims 19-22 as set out above and submits the following arguments in traversal of the prior art rejections.

Applicant submits that claim 1 is believed to be patentable because the Examiner has failed to establish a *prima facie* case of obviousness. Specifically, the Examiner has failed to provide the suggestion or motivation for modifying Scifres. In the Office Action, the Examiner states that:

> it is within the general skill of a worker in the art at the time [of] the invention to provide Scifres et al. '641 the GaN semiconductor as disclosed by the Applicant or Shin '328 for the intended light beam use.

However,

> [a] statement that modifications of the prior art to meet the claimed invention would have been "well within the ordinary skill of the art at the time the claimed invention was made" because the references relied upon teach that all aspects of the claimed invention were individually known in the art is *not* sufficient to establish a *prima facie* case of obviousness *without some objective reason to combine the teachings of the references.*

[1] Applicant's undersigned representative has confirmed with the Examiner that claim 5 is merely objected to and not rejected over prior art. The claim recites "laser oscillation threshold value" and this feature is listed as allowable subject matter in the Office Action.

M.P.E.P. § 2143.01 (emphasis added). In the Office Action, the Examiner has not provided any objective reason to combine Scifres with the supposed teachings of Applicant's disclosure or with the teachings of Shin. While Examiner states that the combination of the supposed teachings of Scifres and the Applicant's disclosure or the teachings of Shin is "for the intended light beam emission use," the Examiner does not provide any objective reason which suggests or motives the modification of Scifres with a GaN type semiconductor light emitting element. Without any suggestion or motivation to modify the teachings of Scifres, it would not have been obvious to one skilled in the art to modify Scifres as suggested by the Examiner. Therefore, claim 1 is believed to be patentable.

Claims 2-4, 8, 9, 13, 16, and 17, which depend from claim 1, are believed to be patentable for at least the reasons submitted for claim 1.

For reasons similar to those submitted for claim 1, claims 6 and 14 and dependent claims 7 and 15 are believed to be patentable.

Claims 19-22 have been added to describe the invention more particularly.

In view of the above, reconsideration and allowance of this application are now believed to be in order, and such actions are hereby solicited. If any points remain in issue which the Examiner feels may be best resolved through a personal or telephone interview, the Examiner is kindly requested to contact the undersigned at the telephone number listed below.

The USPTO is directed and authorized to charge all required fees, except for the Issue Fee and the Publication Fee, to Deposit Account No. 19-4880. Please also credit any overpayments to said Deposit Account.

Respectfully submitted,

for _____ #40,766

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